

REMARKS

Claims 9 to 16 are now pending.

Applicants thank the Examiner for allowing claims 9, 10 and 13 to 16.

Claims 11 and 12 were rejected under the first paragraph of 35 U.S.C. § 112 as to the enablement requirement.

The rejections are not understood, since both claims 11 and 12 are expressly supported by the present application, including the disclosure at lines 8 to 14 of page 6 of the Substitute Specification (and lines 12 to 18 of page 6 of the original specification), which states the following:

As Figure 3 shows, substrate 12 is situated on a layer 42 having a doping opposite that of substrate 12 (i.e., P doping according to this example) to which ground potential 43 is connected. Layer 42 may be made of partial layers 44 and 46 having different charge carrier doping of the same type of conductivity. Due to the arrangement of layer 42, another pn junction 48 develops, its blocking voltage being determined by the doping of layer 42. Due to the stepwise doping of layers 44 and 46, the blocking voltage may be increased by using the resurf effect.

Due to the structuring of semiconductor component 10 illustrated in Figure 3, it is possible to implement a resurf technology by which the structure of semiconductor component 10 may be achieved easily.

(Substitute Specification, page 6). In view of the foregoing, the statements of the Office are simply not understood, since the foregoing makes plain that a person having ordinary skill in the art would understand that the claims are enabled by the specification.

As to the statement that “one skilled in the art is unable to use the claimed invention because there is no clear explanation in the specification as how [sic] the claimed device is function [sic]”, this statement does not support an enablement rejection under the law, since it does not represent the standard for determining whether the enablement requirement is satisfied..

In particular, as regards the enablement rejections under the first paragraph of 35 U.S.C. § 112, it is respectfully submitted that the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how

to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407))). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

It is believed that the present assertions of the Office Action do not meaningfully address -- as they must under the law -- whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation -- which it plainly does, as explained above. In short, it is believed

that the Office Action's arguments and assertions do not really address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims -- a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the subjective assertions of the Office Action are simply not supported by any real "evidence or sound scientific reasoning" -- which the law requires and which makes plain that the Office (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (See id. at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Office Action has not satisfied the foregoing for establishing that undue experimentation would be required, and it is therefore respectfully requested that the enablement rejections be withdrawn as to claims 11 and 12.

It is therefore respectfully submitted that claims 11 and 12 are allowable, like allowed claims 9, 10 and 13 to 16.

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CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that 11 and 12 are allowable, like allowed claims 9, 10, and 13 to 16. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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